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EXAMINER

FUNK, STEPHEN R

ART UNIT	PAPER NUMBER
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2854

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20040302

Application Number: 09/887,334
Filing Date: June 25, 2001
Appellant(s): MORI ET AL.

Allison M. Tulino
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 26, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 13 - 16 and 19 - 22.

Claims 17, 18, and 23 - 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1 - 12 are withdrawn from consideration as not directed to the elected invention.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on September 25, 2003 has not been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 13 - 16 and 19 - 22 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

JP 2000-62,335	Suda	2-2000
US 6,048,654	Nakayama et al.	4-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 13, 16, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Suda. Suda teaches a mounting section (11) which mounts an original plate having photo catalyst power (titanium oxide), a processing section (12), an activation light irradiation section (15), means for heating (17) the plate so that the surface of the plate becomes 40 through 200°C (paragraphs [0043] and [0047] of Suda), a section (16) which supplies ink and damping solution, and a printing section (13). See Drawing 6 of Suda, for example. The recitation of heating the plate “during” irradiating does not distinguish the claimed “means for heating” from the means for heating (17) disclosed by Suda since both heat the surface of the plate. Nevertheless, the means for heating (17) disclosed by Suda is structurally capable of heating the plate during irradiating to the extent that applicant’s means for heating is structurally capable of heating the plate during irradiating.

Claims 14, 15, 19, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suda in view of Nakayama et al. This rejection is set forth in the prior Office Action of June 25, 2003.

(11) Response to Argument

Appellant argues that the means-plus-function limitation “means for heating said original plate during irradiating” requires the examiner to give patentable weight to the entire function of this recitation. In particular, appellant submits that the examiner has failed to establish that the means for heating (17) of Suda performs the identical function of heating an original plate *during* irradiating of activation light.

However, the examiner contends that appellant has misconstrued the function of the means for heating. The only function of the “means for heating” in claim 13 is heating the plate. On the one hand, it is not apparent how a means for heating could be limited by *when* it is activated with electrical power. There is no structural or functional difference in a means for heating if it is arbitrarily activated simultaneously with a light irradiation section or if it is activated sequentially before a light irradiation section. See page 5 of appellant’s brief.

On the other hand, the recitation of the means for heating cannot limit *when* the light irradiation section is activated. The claim could just as easily be interpreted as activating the light irradiation section *during* heating with the means for heating. It is therefore evident that the means for heating *per se* does not distinguish from the means for heating disclosed by Suda.

It is important to note that claim 13 sets forth an apparatus, wherein the light irradiation section and the means for heating are two separate and distinct elements arranged about a common mounting section. Whether or not 35 U.S.C. § 112, sixth paragraph, applies, it is improper to limit an apparatus claim by the particular *process* of when two separate and distinct elements are activated.

Regarding appellant’s argument in the paragraph bridging pages 5 and 6 of the brief, the examiner does not maintain that the means for heating (17) of Suda is an equivalent of

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appellant's processing section (2). Clearly, Drawing 6 of Suda shows the processing section (14) separate from the means for heating (17). Although appellant has disclosed one embodiment in Figure 2 where the processing section (2) includes the means for heating, appellant states on page 2 of the brief that this is "an illustrative, non-limiting embodiment of the invention". Note, for example, appellant's Figures 4 and 5 where the means for heating (58, 59) is located within the mounting section (1) and clearly separate from the processing section (2) which applies a hydrophobic substance to the plate (P) which is on the external surface of the mounting section. In fact, appellant's processing section and the means for heating as recited in claim 13 have no relation. Appellant repeats this argument on page 7 of the brief by stating "since dryer 17 of Suda does not heat during irradiation, Appellant submits that dryer 17 cannot be a structural equivalent to the heater of the hydrophobic processing section 2". Again, this argument is misleading since the claim does not require any relationship between the means for heating and the hydrophobic processing section. Certainly, appellant is not now arguing that this is the only embodiment encompassed by the means-plus-function language utilized in claim 13.

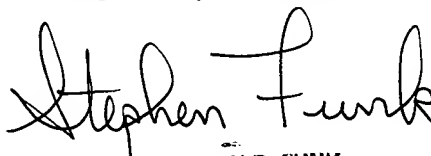
It is also important to note that the means for heating (17) disclosed by Suda is structurally capable of heating the plate during irradiating to the extent that appellant's means for heating is structurally capable of heating the plate during irradiating. Note again the embodiment in appellant's Figure 2 which shows the light irradiation section (5) on the opposite side of the mounting section (1) from the processing section (2) which, as addressed directly above, includes the means for heating. Accordingly, if appellant's means for heating (2) can heat during irradiating with the oppositely located light irradiation section (5) then so can Suda's

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means for heating (17) heat during irradiating with the light irradiating section (15). See Drawing 6 of Suda.


Appellant's remaining argument that the prior art element perform the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification is no different from appellant's first argument. The examiner maintains that the means for heating disclosed by Suda does perform the function specified in the claim in substantially the same manner as the function described in appellant's specification; it heats the plate.

Respectfully submitted,


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